

REMARKS

The specification has been amended. Claims 2-10, 14-45, 53-117, 119-148, 150-153, 155, 157, 163-169, 171-293, 295, 297-312, and 320-420 have been canceled. Claims 1, 13 and 149 have been amended. Claims 1, 11-13, 46-52, 118, 149, 154, 156, 158-162, 170, 294, 296, and 313-319 remain in the application.

The amendment to the specification is made to draw the examiner's attention to co-pending related patent applications.

Claims 1 and 13 are amended to rectify formal errors of antecedent basis. These amendments are directed to matters of form and are not made to evade prior art or to render the claims patentable in the face of a rejection.

Claim 149 is amended to rectify an interruption in its chain of dependency resulting from the cancellation of claim 135. Claim 149 now depends from claim 118, which remains in the application. This amendment is directed to a matter of form and is not made to evade prior art. Accordingly, the applicants request withdrawal of the rejection of claim 149 under 35 USC 112.

Claims 1, 11-13, 46-52, 118, 149, 154, 156, 158-162, 170, 294, 296, and 313-319 are provisionally rejected for obviousness-type double patenting over various claims of co-pending US Patent Application No. 09/679,039, US Patent Application No. 09/679,038, US Patent Application No. 09/728,693, US Patent Application No. 09/668,553, US Patent Application No. 09/668,331, US Patent Application No. 09/668,632, US Patent Application No. 09/668,515, US Patent Application No. 09/668,631, and US Patent Application No. 09/668,600. In view of the fact that prosecution is still ongoing in those applications, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in these applications.

Rejection for Anticipation

Claims 1, 11, 12, 46-52, 170, 294, 296, and 313-319 are rejected for anticipation by US Patent No. 5,848,397 ("Marsh"). That rejection is respectfully traversed for the following reasons.

Claim 1, which is representative of the rejected claims, is directed to software for use on a client device that is configured for communications with a multiplicity of other client devices via a communications network. The software includes a communications function that effects send e-mail and receive e-mail communication links between the

client device and an e-mail service provider server system via the communications network and an advertisement download communication link between the client device and an advertisement distribution server system via the communications network, at selected advertisement download times, as well as e-mail composition, send and receive functions, and

“an advertisement download function that downloads advertisements from the advertisement distribution server system via the advertisement download communication link;

wherein the e-mail service provider server system and the advertisement distribution server system are separately controlled.”

All of the functions recited in the rejected claims are functions of “software for use on a client device”. Although they may interact or operate co-operatively with devices, computers, servers, other than the “client device”, none of the claimed functions is part of, or for use on, any device other than the recited client device. In particular, none of the functions is part of or performed by a server.

Marsh discloses message (ad) presentation functions that are distributed between a client computer and a server system. The complete disclosure of Marsh’s system includes the subject matter of US Patent Application Serial No. 08/948,779 (now US Patent No. 6,014,502 of Moraes), incorporated by reference into Marsh at col. 2, lines 12-21. Moraes, in turn, incorporates US Patent Application Serial No. 08/635,275 (now US Patent No. 5,838,790 of McAuliffe). In Marsh’s system, advertisements are selected by, obtained by, and transferred by a mail server in a server system 104 that is “an electronic mail (e-mail) system which functions as an electronic post office.” See Marsh at col. 6, lines 15-17. The advertisements are downloaded by the e-mail server system to a client system in response to the client connecting to a mail server. See Moraes at col. 21, lines 3-6, and McAuliffe at col. 5, lines 62-64. According to Marsh at col. 16, lines 19-22, the advertisement download scheduler in the server system “controls the transfer of advertisements *from a Mail server M_n* to a client system 101.” (Applicants’ emphasis.) When the client system receives the downloaded ads, they are detected and stored by an advertisement display scheduler residing on a user computer. See Marsh at col. 3, lines 5-11. Marsh therefore omits disclosure of advertisements that are downloaded by “software for use on a client device” from an “advertisement distribution server system”.

Claims 1, 11, 46-52, and 170

With respect to claims 1, 11, 46-52, and 170 the contention in the Office Action is that Marsh teaches software for use in a client device which includes “an advertisement download function that downloads advertisements from the advertisement distribution server system via the advertisement download communication link (Figure 8).” But Figure 8 of Marsh omits any illustration of “software for use on a client device” that comprises “an advertisement download function that downloads advertisements from the advertisement distribution server system via the advertisement download communication link”. Indeed Figure 8 omits any disclosure whatsoever of the structure of the client system 101. In fact, the only advertisement download function disclosed by Marsh resides in an “advertisement download scheduler” that “is located at the server system 104.” As stated above, Marsh teaches that the “*server system*” includes the advertisement download scheduler which “determines when the advertisements are transferred to each user.” According to Marsh’s description of Figure 8 at col. 16, lines 19-22, the advertisement download scheduler in the server system 104 “controls the transfer of advertisements from a Mail server M_n to a client system 101.” McAuliffe, incorporated via Moraes into Marsh, states explicitly that “the e-mail system of the representative embodiment can download to a client computer 2 a number of advertisements”. In contrast the rejected claims explicitly recite that the “advertisement download function” is in “software for use on a client device”. Marsh does not disclose software for use on a client device with any function that “downloads advertisements”.

The “software for use on a client device” of claim 1 includes “a communications function that effects” send and receive e-mail communication links “between the client device and an e-mail service provider server system” and “an advertisement download communication link between the client device and an advertisement distribution server system”. Claim 1 further recites that “the e-mail service provider server system and the advertisement distribution server system are separately controlled”. The further contention in the Office Action is that “the e-mail service provider server system and the advertisement distribution server system are separately controlled” is taught in Figure 8 of Marsh. The applicants respectfully submit that this is incorrect. Marsh’s Figure 8 shows multiple links between a client computer and a server system 104 described as “an electronic mail (e-mail) system which functions as an electronic post office”. The figure also shows a link for transferring advertisements from an advertiser 108 to the e-mail server system 104, but no link for transferring advertisements from the advertiser to

the client device. The e-mail server system 104 is a single, unified server system that downloads both e-mail and advertisements to a client device. Figure 8 of Marsh does not show any “software for use on a client device that downloads advertisements from an advertisement distribution server system and downloads e-mail from a “separately controlled” e-mail service provider server system.

Claim 12

With respect to claim 12, the contention is that “the advertiser 108 determines the ads to be sent to the client computer 101 ... (Figure 8)”. The applicants respectfully submit that this is incorrect. Marsh in Figure 8 only teaches that the server system receives advertisements from an advertiser. See Marsh at column 14, lines 25-27. Marsh at column 15, lines 31-34 says that the advertisement distribution scheduler that “is located at the server system 104” is the entity that “generates an assignment of advertisements to users and their computers”. In fact, claim 12 recites that the advertisement display function controls advertisement display “in accordance with ad display parameters prescribed by the advertisement distribution server system, which ad display parameters are unknown to the e-mail service provider”. However, Marsh’s e-mail server system 104 transmits advertisements to a client system 101, each of which includes control information such as “the maximum number of times the advertisement may be shown to a user” which establishes that the e-mail server system 104 both knows of and provides at least one “ad display parameter”.

Claims 294, 296, and 313-315

As to claims 294, 296, and 313-315, the contention is that Marsh in Figure 8 and at column 15 lines 1-10 describes software for use on a client device with:

“a playlist request function that generates a playlist request that includes a current playlist(s) ID that identifies a current playlist(s);

a playlist request transmit function that transmits the playlist request to at least one playlist server; and

a playlist response handling function that receives and processes a playlist response generated by the at least one playlist server in response to the playlist request;

wherein the playlist response includes an at least one new playlist that includes a plurality of ad identifiers that identify corresponding advertisements, a plurality of addresses that identify the source of respective ones of the advertisements, and at least one new playlist ID that identifies the at least one new playlist.”

Figure 8 shows an e-mail server system 104. Neither the visible contents nor the description of Figure 8 teaches a “playlist”, a “playlist request function”, a “playlist request transmit function”, a “playlist response handling function”, or a “playlist server”. Marsh at column 15, lines 1-10 describes a statistics log file containing the identities of ads that have been displayed together with the times and dates of display. The statistics log file is maintained by the advertisement display scheduler 700 of the client system 101. The display scheduler 700 of the client system uses the statistics log file to determine which ads to display subsequently. The statistics log file can be used by the server system 104 for billing and reporting.

Where in this passage is a “playlist” or any of the functions or elements related to it described? In fact, the term does not appear in this or any other passage of Marsh. The applicants therefore presume that the “playlist” recited in these claims is being construed as a statistics log file. However, this is supported neither by any plain meaning of the term, nor by the definition of the term in the specification at page 38, lines 5-10: “The PlayList is in its essence a list of URNs from which to fetch the actual ads as well as a set of attribute-value pairs, on a per-ad basis”. Further, the display scheduler 700 maintains its own statistics log file; it does not generate a “playlist request” for the statistics log file, it does not transmit any request for a statistics log file to any server, let alone a “playlist server”, nor does it receive and process a response to a request for a statistics log file from any server, let alone a “playlist server”. Indeed, according to Marsh’s Figure 8, this file is transmitted *by* the client 101 *to* the server 104. Therefore, whatever the statistics log file is, it is manifestly not a “playlist response” or a response of any kind that is transmitted *to* a client *by* a server.

Claims 316-319

Claims 316-318 depend from claims 313-315 and are distinguishable from Marsh for the reasons given in support of those claims.

Accordingly, Marsh omits one or more elements of claims 1, 11, 12, 46-52, 170, 294, 296, and 313-319 and cannot anticipate them. This rejection should therefore be withdrawn.

Rejection for Obviousness

Claims 13, 118, 149, 156, and 158-162 are rejected for obviousness over Marsh. That rejection is traversed for the following reasons.

Claim 13

According to claim 13, the software for use on a client device includes “a user activity monitor function that is activated when the software is operating in a first operating mode, wherein the user activity monitor function generates user activity information that is used by the advertisement display function in controlling a duration for which advertisements are displayed”.

One contention in the Office Action is that Marsh teaches an ad display parameter in the form of a face time duration parameter at col. 3, lines 28-36. The applicants respectfully disagree. In this passage, Marsh discusses an advertisement download scheduler in a server system (not in “software for use on a client device”) that “determines when the advertisements are transferred to each user,” in what order they are transferred, and how many are transferred at any given time. There is no teaching or suggestion of “a user activity monitor function” in “software for use on a client device” to generate user activity while the “software” is “operating in a first operating mode.”

The other contentions that support the rejection of claim 13 for obviousness relate to “face time duration” and “prescribed minimum level of user activity”. Neither of these limitations is recited in claim 13. Further, the examiner has given no consideration to the “first operating mode” that is explicitly recited in claim 13.

Accordingly, no suggestion to modify Marsh is established and the proposed modification lacks a “user activity monitor that is activated when the software is operating *in a first mode*” to be used by the advertisement display function “in controlling a duration for which advertisements are displayed” (applicants’ emphasis), and the rejection of claim 13 must be withdrawn for failure to satisfy the requirements for prima facie obviousness. See MPEP 2142 et seq.

Claim 118

According to claim 118, the software for use on a client device is characterized by at least three operating modes, including:

“a first operating mode in which the advertisement download function is activated;

a second operating mode in which the advertisement download function is not activated;

a third operating mode in which the advertisement download function is not activated;

wherein the software includes an enhanced set of e-mail features when operating in either the first or third operating mode, and includes a reduced set of e-mail features when operating in the second operating mode; and

wherein the software is free when operating in either the first or second operating mode, but must be paid for when operating in the third operating mode.”

As pointed out previously, advertisements are downloaded in Marsh’s system by an advertisement download scheduler in a server system, not by an advertisement download function in software for use on a client device. Marsh simply omits “software for use on a client device” having multiple operating modes differentiated by any function that “downloads advertisements” and/or by payment for the software.

The examiner has entered official notice that it is well known in the computer arts to switch e-mail features from a first operating mode to a second operating mode when a problem arises with one of the operating modes in order to permit software to operate with fewer features and fewer problems, and has concluded that such official notice makes it obvious to switch from a first operating mode to a second operating mode. The examiner has further concluded that a third operating mode is obvious based on official notice that it is well known for products not to be free when a customer doesn’t receive advertisements in order to motivate the customer to change to a mode accompanied by free products. The rejection parses claim 118 into two inventions, one for switching from a first mode to a second mode, another for an operating mode in which products and services are not free. This analysis fails to consider the invention as a whole (see MPEP 2141.02), posits technical facts in computer software, an area of esoteric technology, that are unsupported by citation to a reference (see MPEP 2144.03), and disregards limitations and elements that are explicitly recited in the claim (see MPEP 2143.03).

Consequently, the rejection of claim 118 must be withdrawn for failure to satisfy the requirements for prima facie obviousness. See MPEP 2142 et seq.

Claim 149

Claim 149 further limits the software for use on a client device of claim 118 by

“an advertisement download monitor function that is activated when the software is in the first operating mode, wherein the advertisement download monitor function determines whether or not an ad download failure condition has occurred, whereby the ad download failure condition occurs when the advertisement download function has not successfully downloaded advertisements over a prescribed time period;

an e-mail function monitor function that determines whether or not an e-mail function failure condition has occurred, whereby the e-mail failure condition occurs when the software has not successfully sent and/or received e-mail messages over the prescribed time period; and

an adware failure nag function that is activated when the software is in the first operating mode upon detection that an ad download failure condition has occurred and an e-mail function failure condition has not occurred, whereupon the adware failure nag function generates an adware nag failure display at prescribed ad failure nag intervals, wherein the adware nag failure display notifies the user that advertisements have not been successfully downloaded, and warns the user that the operating mode of the software will be switched from the first operating mode to the second operating mode if the ad download failure condition is not rectified.”

According to the Official Action, this recitation constitutes “a switching function that switches the operating mode upon expiration of a maximum ad display failure time and notifying the user if the user doesn’t take corrective action.” The applicants respectfully submit that this is an inaccurate characterization as can be appreciated with reference to the quoted subject matter immediately preceding this paragraph. This analysis fails to consider the invention as a whole (see MPEP 2141.02) and disregards limitations and elements that are explicitly recited in the claim such as the advertisement download monitor function, the e-mail function monitor function, and the adware failure nag function (see MPEP 2143.03). Consequently, the rejection of claim 149 must be withdrawn for failure to satisfy the requirements for prima facie obviousness. See MPEP 2142 et seq.

Claims 154 and 156

As to claims 154 and 156, the rejection fails to consider the invention as a whole (see MPEP 2141.02), takes official notice of technical facts (a counter function) in computer software, an area of esoteric technology, that are unsupported by citation to a reference (see MPEP 2144.03), and disregards limitations and elements that are explicitly recited in the claim, such as a counter that is incremented once each day that advertisements are not successfully downloaded (see MPEP 2143.03). Consequently, the rejection of claims 154 and 156 must be withdrawn for failure to satisfy the requirements for prima facie obviousness. See MPEP 2142 et seq.

Claims 158-160

As to claims 158-160, the rejection fails to consider the invention as a whole (see MPEP 2141.02), takes official notice of technical facts (switching operating modes) in computer software, an area of esoteric technology, that are unsupported by citation to a reference (see MPEP 2144.03), and disregards limitations and elements that are explicitly recited in the claim, such as a maximum ad failure time period and a deadbeat user alert function (see MPEP 2143.03). Consequently, the rejection of claims 158-160 must be withdrawn for failure to satisfy the requirements for prima facie obviousness. See MPEP 2142 et seq.

Claims 161-162

Claims 161 and 162 recite software for use on a client device advertisement with storage and display functions that further comprehends:

“an obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement currently being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display; and

an obscured ad nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured ad nag display notifies the user of the obscured ad condition.”

The contention in the Office Action is that, since Marsh at column 7, line 66 through column 8, line 30 teaches monitoring and displaying various showcase ads which can occupy the entire portion of the display, along with banner advertisements, “then it would have been obvious to a person of ordinary skill in the art at the time of the Applicants’ invention to have included” the detection of ad obscuration and notice to the

user “in order for the user to be aware that it might not be compensated for viewing the banner advertisements that is being obscured by the Showcase advertisement.”

As implicitly conceded in the Office Action, at the time the invention was made the prior art did not teach a client device software with advertisement download, storage, and display functions that includes “an obscured ad monitor function” and “an obscured ad nag function”. See MPEP 2141.01 III. In fact, the only way which such an invention could be appreciated during examination is with reference to the applicants’ specification. However, such hindsight reasoning is expressly forbidden. See *In re Dembiczak*, 50 USPQ2d at 1617, (Fed. Cir. 1999).

The only support given for the proposed modification of Marsh by addition of the obscured ad detection and nag functions is the assertion that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made” because Marsh teaches monitoring and displaying showcase ads that might obscure banner ads. In fact, Marsh teaches monitoring, displaying, and scheduling ad display, the latter function being provided, in part, to control the display “of both the banner advertisements 600 and the showcase advertisements 1001.” See Marsh at column 8, lines 35-40. This function maintains prioritized queues of ads, stepping through the current queue and displaying ads according to a priority order “until all of the advertisements” in the queue have been shown. The next queue is then accessed, and so on. See Marsh at column 9, lines 7-19. In order to ensure that a user actually views the ads, the scheduler function monitors user activity and times out when there is no such activity. Marsh does not teach that one ad may obscure another ad; indeed, the teaching is that “all” of the advertisements are shown.

In contrast, a problem addressed by the rejected claims is obscured or hidden ads as exemplified by “the relative ease with which a user might be able to hide the ads from view by placing a small window directly over the ad. “ See the specification at page 36, lines 6-13. In the invention of the rejected claims this problem is solved by the claimed software which “performs a check to determine that the ad is both onscreen and uncovered. If the screen state does not satisfy both of these criteria, the software will either nag the user to uncover the ad or automatically re-order the windows so that the ad is uncovered.” See the specification at page 36, lines 8-13. This solution is implemented in the obscured ad detection and nag functions that are explicitly recited in claim 161, and that also limit claim 162.

Marsh does not teach or suggest any action at all that hides ads; banner and showcase ads are scheduled to ensure that all ads are displayed, and ad display is timed out when user activity ceases. Marsh's message presentation apparatus simply doesn't have any need to detect hiding an ad and nagging to notify a user of such hiding.

Accordingly, there was no suggestion at the time the invention was made to modify Marsh by adding "an obscured ad monitor function" and "an obscured ad nag function". The applicants therefore request the citation of a reference or entry of an affidavit to support the assertion that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made" to so modify Marsh, otherwise, this rejection should be withdrawn. See MPEP 2144.03.


Further, since Marsh has no teaching or suggestion of a "hidden ad" problem, there is no motivation or suggestion to modify it to include the obscured ad detection and nag functions. Marsh does not explicitly teach the obscured ad detection and nag functions; and, without a reference or an affidavit, there is no basis for asserting that those functions are suggested, by Marsh or any other reference of record. Accordingly, no *prima facie* case of obviousness has been established with respect to claims 161 and 162. See MPEP 2143 *et seq.*

Conclusion

In view of these amendments and remarks, it is submitted that the claims in this application are novel and unobvious with respect to, and are therefore allowable over, the references of record, early notice of which is earnestly solicited.

Respectfully submitted,

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By: 
Robert J. O'Connell
Attorney for Applicants
Registration No. 44,265

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121

Telephone: (858) 651-4361
Facsimile: (858) 658-2502